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10/584,424

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Darrell Sleep

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EXAMINER

VOGEL, NANCY TREPTOW

ART UNIT

PAPER NUMBER

1636

NOTIFICATION DATE

DELIVERY MODE

02/22/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Patents-US-NY@novozymes.com

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/584,424 | Applicant(s) SLEEP ET AL. | |
| | Examiner NANCY VOGEL | Art Unit 1636 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38,40-53,55-66 and 69-75 is/are pending in the application.
- 4a) Of the above claim(s) 1-3,5-20,27-37,49-52,57,64-66 and 69-75 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4,21-26,38,40,43-46,53,55,56 and 58 is/are rejected.
- 7) ☒ Claim(s) 41,42,47 and 48 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>6/9/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-38, 40-53, 55-66, 69-75 are pending.

Receipt of the Information Disclosure Statement on 6/9/09 is acknowledged.

Election/Restrictions

Applicant's election with traverse of Group II, species PDI1 in the reply filed on 10/30/09. is acknowledged. The traversal is on the ground(s) that the reference cited, Martzen does not disclose the plasmid encoding a chaperone and a non-2-micron family protein. However, . This is not found persuasive because Martzen discloses expression on a genomewide basis of proteins using a 2 micron plasmid. Martzen et al. discloses expression of proteins of the entire genome, with the non-2 micron protein GST. Therefore, GST and chaperone protein encoding genes are present in the disclose of Martzen. Applicant's statement that it would not be a burden to search all species, therefore traversing the species election requirement, is unsupported by argument. It is maintained that the chaperone protein encoding genes are genetically and chemically distinct and a search for all species would be burdensome.

Furthermore, claims 53, 55, 56, do not read on the elected species since the chaperone protein is ORM2 and therefore these claims are withdrawn.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 22, 23, 58-63 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The MPEP states that the purpose of the written description requirement is to ensure that the inventor had possession, as of the filing date of the application, of the specific subject matter later claimed by him. The courts have stated:

To fulfill the written description requirement, a patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that "the inventor invented the claimed invention." *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997); *In re Gostelli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) ("[T]he description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed."). Thus, an applicant complies with the written description requirement "by describing the invention, with all its claimed limitations, not that which makes it obvious," and by using "such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention." *Lockwood*, 107 F.3d at 1572, 41 USPQ2d at 1966." *Regents of the University of California v. Eli Lilly & Co.*, 43 USPQ2d 1398.

Further, for a broad generic claim, the specification must provide adequate written description to identify the genus of the claim. In *Regents of the University of California v. Eli Lilly & Co.* the court stated:

A written description of an invention involving a chemical genus, like a description of a chemical species, "requires a precise definition, such as by structure, formula, [or] chemical name," of the claimed subject matter sufficient to

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distinguish it from other materials. *Fiers*, 984 F.2d at 1171, 25 USPQ2d 1601; *In re Smythe*, 480 F.2d 1376, 1383, 178 USPQ 279, 284985 (CCPA 1973) (“In other cases, particularly but not necessarily, chemical cases, where there is unpredictability in performance of certain species or subcombinations other than those specifically enumerated, one skilled in the art may be found not to have been placed in possession of a genus ...”) *Regents of the University of California v. Eli Lilly & Co.*, 43 USPQ2d 1398.

The MPEP further states that if a biomolecule is described only by a functional characteristic, without any disclosed correlation between function and structure of the sequence, it is “not a sufficient characteristic for written description purposes, even when accompanied by a method of obtaining the claimed sequence.” MPEP § 2163.

The MPEP does state that for a generic claim the genus can be adequately described if the disclosure presents a sufficient number of representative species that encompass the genus. MPEP § 2163. If the genus has a substantial variance, the disclosure must describe a sufficient variety of species to reflect the variation within that genus. See MPEP § 2163. Although the MPEP does not define what constitute a sufficient number of representative species, the courts have indicated what do not constitute a representative number of species to adequately describe a broad generic. In *Gostelli*, the courts determined that the disclosure of two chemical compounds within a subgenus did not describe that subgenus. *In re Gostelli*, 872, F.2d at 1012, 10 USPQ2d at 1618.

The MPEP lists factors that can be used to determine if sufficient evidence of possession has been furnished in the disclosure of the Application. These include: (1) Actual reduction to practice, (2) Disclosure of drawings or structural chemical formulas, (3) Sufficient relevant identifying characteristics (such as: i. Complete structure, ii. Partial structure, iii. Physical and/or chemical properties, iv. Functional characteristics

when coupled with a known or disclosed, and correlation between function and structure), (4) Method of making the claimed invention, (5) Level of skill and knowledge in the art, and (6) Predictability in the art.

“Disclosure of any combination of such identifying characteristics that distinguish the claimed invention from other materials and would lead one of skill in the art to the conclusion that the applicant was in possession of the claimed species is sufficient.”

MPEP § 2163. While all of the factors have been considered, a sufficient amount for a *prima facie* case are discussed below.

In the instant case, the claims are drawn to a genus of host cells comprising a plasmid encoding an essential chaperone, or the plasmid, wherein in the absence of the plasmid the host cell is inviable. Claims 61 recite a plasmid comprising as a sole selectable marker a gene encoding an essential chaperone. Therefore the claims are drawn to a genus of cells which are inviable presumably in the absence of a particular chaperone protein, and a genus of any plasmids encoding any chaperone protein which is essential in any particular cell.

As stated *supra*, the MPEP states that written description for a genus can be achieved by a representative number of species within a broad generic. It is unquestionable that these claim(s) are broad and generic, with respect to all possible compounds encompassed by the claims. The possible structural variations are numerous to any chaperone protein which is essential to any cell under any conditions. Specifically, the claims lack written description because one of ordinary skill in the art could not reasonably predict the structure of any chaperone protein in any cell which is

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essential for viability under any conditions. Although the claims recite some functional characteristics, the claims lack written description because there is no disclosure of a correlation between function and structure of the compounds beyond those compounds specifically disclosed in the examples in the specification. Moreover, the specification lack sufficient variety of species to reflect this variance in the genus. The description requirement of the patent statute requires a description of an invention, not an indication of a result that one might achieve if one made that invention. See *In re Wilder*, 736, F.2d 1516, 1521, 222 USPQ 369, 372-73 (Fed. Cir. 1984) (affirming rejection because the specification does “little more than outlin[e] goals appellants hope the claimed invention achieves and the problems the invention will hopefully ameliorate.”) Accordingly, it is deemed that the specification fails to provide adequate written description for the genus of the claims and does not reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the entire scope of the claimed invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 4 , 21-26, 58, 61-63 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 and by dependence 21-26, are vague and indefinite in the recitation of “wherein if the plasmid is based on the 2um-plasmid then it is a distintegration vector”.

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It is not clear how this further limits the first phrase of the claim, i.e. "A 2um-family plasmid".

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 62 recites the broad recitation "a non-um-family plasmid protein", and the claim also recites "such as a non-2um-family plasmid protein as defined in Claim 14" which is the narrower statement of the range/limitation.

Claim 58 and by dependence claims 61-63 is vague and indefinite in the recitation of "an essential chaperone", since it is not clear in what sense the chaperone is "essential".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 4, 21-26, 38, 40-48, are rejected under 35 U.S.C. 102(b) as being anticipated by Martzen et al. (Science, 286, no. 5442:1153-1155, 1999).

Martzen et al. disclose genome wide expression of proteins from a 2 micron based plasmid. Since the reference discloses expression of proteins on a genome wide basis, it is apparent that chaperone proteins, including PD1, are expressed as GST (non 2 um protein) fusions, i.e. there is expression of a chaperone protein and a non-2 micron protein expressed on the plasmid.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 38, 40, 43-46 are rejected under 35 U.S.C. 102(e) as being anticipated by Conneely (US Pat. 5,571,691).

Conneely disclose a host cell comprising recombinant lactoferrin, expressed in a yeast cell, using a plasmid which is 2 um based (see abstract, . Since the endogenous protein PDI 1 would be present in the genome of the cell, and since "recombinant" does not distinguish over the native PDI1 gene, the reference anticipates the claims.

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Claims 41, 42, 47, 48 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NANCY VOGEL whose telephone number is (571)272-0780. The examiner can normally be reached on 7:00 - 3:30, Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on (571) 272-0951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/NANCY VOGEL/
Primary Examiner, Art Unit 1636

NV
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